

REMARKS

The Examiner rejected claims 1-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gershman and further in view of Brockman et al. (US 2002/0123919). Applicants respectfully traverse the §103(a) rejections with the following arguments.

Serial No.: 09/810,629

10

35 U.S.C. §103(a)

The Examiner rejected claims 1-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gershman in view of Brockman et al. (US 2002/0123919).

Applicants respectfully contend that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, because Gershman in view of Brockman does not teach or suggest each and every feature of claims 1, 7, 11, 15, 19, 23, and 25. For example, Gershman in view of Brockman does not teach or suggest the following features of claims 1, 7, 11, 15, 19, 23, and 25:

“generating a report responsive to the outcome; and ... providing the report to at least two clients of the service provider; wherein the acts of analyzing, generating, and providing are performed by a management service”,
wherein the report is responsive to the outcome derived from analyzing the information on the service provider's:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);
- 3) security (claims 11 and 23); and
- 4) availability (claims 15 and 27).

The Examiner argues that Gershman, col. 34, lines 8-42 discloses the preceding features of claims 1, 7, 11, 15, 19, 23, and 25.

In response, Applicants note that in Gershman, col. 34, lines 8-42, the report is in response to a request by a user for a product report about product X (see Gershman, col. 34, lines

Serial No.: 09/810,629

11

21-22). The report is provided to the user requesting the report, and the report comprises ratings of the product X by users who have previously rated the product X (see Gershman, col. 34, lines 25-26, 38-42). Thus, Applicants respectfully contend that:

A) Gershman, col. 34, lines 8-42 does not disclose that the user requesting the report is a client of the service provider, as required by claims 1, 7, 11, 15, 19, 23, and 25.

B) Gershman, col. 34, lines 8-42 does not disclose that the report is provided to at least two clients of the service provider, as required by claims 1, 7, 11, 15, 19, 23, and 25 (i.e., Gershman discloses the only receiver of the report to be the one who requested the report).

C) Gershman, col. 34, lines 8-42 does not disclose that the report is responsive to the outcome derived from analyzing the information on the service provider's:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);
- 3) security (claims 11 and 23); and
- 4) availability (claims 15 and 27).

Gershman discloses only that the report pertains to rating the product X by users who have previously rated the product. Gershwin does not disclose what aspects of the product X are rated. Gershman does not disclose that any information about the provider of product X is in the report. Indeed, Gershman discloses only that the report includes ratings of the product X, and Gershman does not disclose that the report includes ratings of the provider of product X. In fact, Gershwin does not even disclose that the provider of the product X is a service provider; indeed, Applicants assert that a provider of a product X is reasonably inferred to be a product provider and not a service provider.

Serial No.: 09/810,629

12

In addition, Gershman does not disclose the following feature of claims 1, 7, 11, 15, 19, 23, and 25: gathering information about a service provider's:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);
- 3) security (claims 11 and 23); and
- 4) availability (claims 15 and 27).

Applicants assert that there is no disclosure anywhere in Gershman relating to gathering information about a service provider's characteristics, performance, security, or availability.

The Examiner argues that Gershman discloses the preceding first feature of claims 1, 7, 11, 15, 19, 23, and 25 in Gershman's abstract; FIGS 1A and 1B, and col. 34, lines 8-42. In response, Applicants maintain that Gershman's abstract; FIGS 1A and 1B, and col. 34, lines 8-42 does not disclose gathering information about a service provider's characteristics, performance, security, or availability. Applicants note that Gershman, col. 34, lines 8-42, discloses an algorithm for determining the personalized product ratings of a user, which is unrelated to the preceding first feature of claims 1, 7, 11, 15, 19, 23, and 25. The Examiner has been unable to cite specific language in Gershman that allegedly discloses information about a service provider's characteristics, performance, security, or availability.

In addition, Gershman does not disclose the following feature of claims 1, 7, 11, 15, 19, 23, and 25: analyzing, to provide an outcome, the information on the service provider's:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);

Serial No.: 09/810,629

13

3) security (claims 11 and 23); and

4) availability (claims 15 and 27).

Applicants note that the Examiner has not provided a citation in Gershman that allegedly teaches or suggests the preceding feature of claims 1, 7, 11, 15, 19, 23, and 25.

In "Response to Arguments", the Examiner states: "The combination of Gershman/Brockman, clearly disclose the gathering information, analyzing it, generating reports, and providing the reports to clients. Obviously, the first three steps are intrinsic to the reporting process, and must be completed before any form of report may be issued. Since Gershman discloses an extensive product review beginning in column 34, it is self-evident that the review of the product must be related to and applicable to the product itself. Using the same steps as disclosed by Gershman, one of ordinary skill in the art could easily modify the Gershman invention to adequately and completely disclose the instant invention. In this case, characteristics, performance, security and availability of an ISP/ASP would be appropriate descriptors of the product/service, as is the framework described by Gershman."

In response, Applicants maintain that the preceding argument by the Examiner is no more than speculation, since the Examiner has not provided any evidence from Gershman or elsewhere in the prior art to support the preceding argument by the Examiner. Moreover, Applicants respectfully contend that the Examiner's allegation that "the first three steps are intrinsic to the reporting process, and must be completed before any form of report may be issued" is incorrect. In Gershman, col. 34, lines 8-42 which describes generating a report, what is analyzed is only the profile of users who have previously rated product X, which does not satisfy the requirement in

Serial No.: 09/810,629

14

of claims 1, 7, 11, 15, 19, 23, and 25 of analyzing the information on the service provider's:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);
- 3) security (claims 11 and 23); and
- 4) availability (claims 15 and 27).

Based on the preceding arguments, Applicants respectfully maintain that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Gershman, and that claims 1, 7, 11, 15, 19, 23, and 25 are in condition for allowance.

Since claims 2-6 depend from claim 1, Applicants contend that claims 2-6 are likewise in condition for allowance.

Since claims 8-10 and 31 depend from claim 7, Applicants contend that claims 8-10 are likewise in condition for allowance.

Since claims 12-14 and 33-34 depend from claim 11, Applicants contend that claims 12-14 and 33-34 are likewise in condition for allowance.

Since claims 16-18 and 35-36 depend from claim 15, Applicants contend that claims 16-18 and 35-36 are likewise in condition for allowance.

Since claims 20-22 and 37-38 depend from claim 19, Applicants contend that claims 20-22 and 37-38 are likewise in condition for allowance.

Since claims 24-26 and 39-40 depend from claim 23, Applicants contend that claims 24-26 and 39-40 are likewise in condition for allowance.

Serial No.: 09/810,629

15

In addition, the Examiner admits that Gershman in view of Gershman does not disclose the features specific to claims 31-42. The Examiner argues that the features specific to claims 31-42

“are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The information collection and storage steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).... Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect from a service provider any type of security information, performance information, and statistical analysis thereof, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.”

In response, Applicants contend that the features specific to claims 31-42 most certainly recite limitations on method steps of claims 31-42. For example, claim 31 recites the limitation: “wherein the information on performance of the application service provider includes information about responsiveness of the application service provider”. Thus claim 31 requires the step of “gathering information on performance of an application service provider” to include gathering information about responsiveness of the application service provider, which is most certainly a limitation on the “gathering information” step. Similarly, claim 31 requires the step of “analyzing the information to provide an outcome” to include analyzing information about responsiveness of the application service provider to provide an outcome, which is most certainly a limitation on the “analyzing information” step.

Serial No.: 09/810,629

16

Likewise, each of claims 32-41 recites a limitation on method steps of claims 31-42. Therefore, since the Examiner has admitted that Gershman in view of Gershman does not disclose the features specific to claims 31-42, Applicants respectfully maintain that claims 31-42 are not unpatentable over Gershman in view of Brockman.

Serial No.: 09/810,629

17

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

Date: 05/10/2005

Jack P. Friedman
Jack P. Friedman
Registration No. 44,688

Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, New York 12110
(518) 220-1850

Serial No.: 09/810,629

18